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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,328	11/13/2003	Stephan S. Porter	47168-00297USPT	9892
30223	7590	06/09/2006	EXAMINER	
JENKENS & GILCHRIST, P.C. 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606			WILSON, JOHN J	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/713,328

Applicant(s)

PORTER ET AL.

Examiner

John J. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 36-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/13/04, 1/31/05</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS continued: 3/28/05</u> .           |

***Election/Restrictions***

Applicant's election of the Group I invention, claims 1-35 in the reply filed on April 21, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 36-40 stand withdrawn as being directed to a non-elected invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-19 and 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Klardie et al (5782918). Klardie shows an abutment 42 for a prosthetic tooth, post as shown at top of the abutment, stem as shown at 60, feedback feature 62 and through bore 81. Klardie teaches that feature 62 is snap fit in the implant bore, column 2, lines 58-60 and column 5, lines 15-20. This snap fit inherently comprises a feedback feature. Noticing an inherent property of a known structure does not patentably distinguish over the structure. The snap fit taught by Klardie is inherently

audible and tactile. As to claims 33 and 35, the user of Klardie will inherently sense feedback in the taught use of the shown structure, and as such, the method steps are inherently taught.

Claims 1-11, 13-24 and 26-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Kumar et al (2004/0038179). Kumar shows an implant 10, Fig. 3B, internal bore 28, implant feedback feature 102, [0049], threaded distal section 30, abutment 50, post 64, stem 56, abutment feedback feature 70, through bore 82, 86 and abutment screw, not shown, however, taught at [0015]-[0016], [0038], and [0047]-[0049]. As taught by these paragraphs, the screw has threads that interface with threads 30 in the implant and a part that interfaces with seat 88, [0047]. To call this part that interfaces with seat 88, a head, is merely terminology in naming parts. As to claim 4, see lip 72. As to claim 5, see recess 102. As to claim 6, see recess as shown above lip 72. As to claim 7, see audible at [0049]. The shown snap fit is held to be inherently tactile, and as such, inherently both tactile and audible. As to claim 10, Kumar shows a first diameter at 90 in Fig. 2D and a second larger diameter 86, and an abutment retention shaft (bolt) that has a diameter larger than the second diameter in order to seat with 88 as taught. As to claim 14, Kumar shows a healing abutment, and as such, does not teach that it is for a prosthetic tooth, however, the language "adapted to support a prosthetic tooth" is met if, as in this case, the shown structure is capable of functioning as claimed. The shown abutment can support a prosthetic tooth if the user

chooses to mount an inferentially claimed tooth on it, and as such, is inherently capable of functioning as claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 13, 20-24 and 26-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klardie et al (5782918) in view of Sutter (6227859). Klardie shows an implant 11, interior bore 25, implant feedback feature 33, abutment 42, post as shown at top of the abutment, stem as shown at 60, abutment feedback feature 62, through bore 81, abutment screw 90 and abutment screw head 93. Klardie does not show an implant threaded section distal to the implant feedback feature or a screw having a distal threaded end. Sutter teaches an implant 1 having a feature 15 for receiving extending portions 241, a distal threaded section 19, and a screw 601, Fig. 19, adapted to engage the threaded section in the implant. It would be obvious to one of ordinary skill in the art to modify Klardie to include mating threads on the implant below the securing feature and on the distal end of the screw in order to better hold the abutment and screw in the implant. Klardie teaches that feature 62 is snap fit in the implant bore, column 2, lines 58-60 and column 5, lines 15-20. This snap fit inherently comprises a feedback feature. Noticing an inherent property of a known structure does

not patentably distinguish over the structure. The snap fit taught by Klardie is inherently audible and tactile. As to claim 6, the stem shows a recess at 60. As to claim 7, the snap fit taught by Klardie will inherently produce a sound, and as to claims 8 and 9, will inherently be tactile. As to claims 33 and 35, the user of Klardie will inherently sense feedback in the taught use of the shown structure, and as such, the method steps are inherently taught.

Claims 12 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klardie et al (5782918) in view of Sutter (6227859) as applied to claims 11 and 20 above, and further in view of Constantino (2003/0224327). Klardie teaches a first internal anti-rotation feature 26, however, the above combination does not show a second anti-rotation feature proximal to the first. Constantino shows using a first anti-rotational feature 18 with a drive tool [0021] and [0027]-[0028], and shows a second anti-rotation feature 32 for mounting an abutment [0027]. It would be obvious to one of ordinary skill in the art to modify the above combination to include first and second anti-rotation features as shown by Constantino in order to better thread the implant in the bone and also better hold a prosthesis in the proper position.

Claims 12 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al (2004/0038179) in view of Constantino (2003/0224327). Kumar teaches a first internal anti-rotation feature 36, however, does not show a second anti-rotation feature proximal to the first. Constantino shows using a first anti-rotational

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feature 18 with a drive tool [0021] and [0027]-[0028], and shows a second anti-rotation feature 32 for mounting an abutment [0027]. It would be obvious to one of ordinary skill in the art to modify Kumar to include first and second anti-rotation features as shown by Constantino in order to better thread the implant in the bone and also better hold a prosthesis in the proper position.

### ***Drawings***

The drawings filed November 13, 2003 have been found to be acceptable by the examiner.

### ***Information Disclosure Statement***

The information disclosure statements filed May 13, 2004, January 31, 2005 and March 28, 2005 have been considered and initialed and signed copies of each are attached.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kumar (6394806) shows a snap fit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached at 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**John J. Wilson**  
**Primary Examiner**  
**Art Unit 3732**

jjw  
June 3, 2006